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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/658,389
Filing Date: September 08, 2000
Appellant(s): THOMSON ET AL.

Paul Ditmyer
For Appellant

EXAMINER'S ANSWER

MAILED

NOV 13 2003

GROUP 3600

This is in response to the appeal brief filed Oct 6, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-6, 8-10, 12, 13, 15, 17-22, 24-31, and 33-38 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,477,747	Cheng	12-1995
5,881,606	Roddy	3-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 8, 9, 19, 28, and 33-38 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office Action, Paper No. 20.

Claims 1-3, 10, 12, 13, 15, 17, and 20-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting. This rejection is set forth in prior Office Action, Paper No. 20.

Claims 1-3, 10, 12, 13, 17, 20, and 21 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 20.

Claims 4-6, 15, 18, 22, 24-27, and 29-31 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 20.

(11) Response to Argument

A) The Claim Rejection Under 35 U.S.C. 112, First Paragraph

After further review and consideration of the appellant's argument, the Examiner withdraws the rejection under 35 U.S.C. 112, first paragraph.

B) The Prior Art Rejection

In response to the appellant's argument that Cheng fails to show the "outer surface portions defining an imaginary cylinder...at least one (or plurality as recited in claim 24)

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fastener(s) receiving passageway therein offset a predetermined distance from an axis defined by the imaginary cylinder”, it is the Examiner’s position that Cheng shows such limitations as broadly interpreted. There appears to be a couple of key words in the claim language that need to be better examined before responding to the appellant’s argument.

1) The words “imaginary cylinder” is defined by the outer surface portions of the pair of cooperating clamp members as recited in the claims. In other words, it is a cylinder that has no mass and is defined by the outer surface **portions** of the clamp members (emphasis added). There is no other definition provided in the specification as originally filed. Looking at the argument that the appellant makes regarding the Examiner’s using of Cheng’s reference, the appellant asserts, on page 12 lines 11-14 of the Appeals Brief, that “contrary to the Examiner’s assertion on page 11 of the Office Action, a ‘cylinder’, circular or oval, cannot be defined by two different sized arcs connected by a step or shoulder, as shown in Cheng.” However, such negating definition is not found anywhere in the specification. The word “cylinder” is defined by Merriam Webster’s Collegiate Dictionary, 10th Edition, as “the surface traced by a straight line moving parallel to a fixed straight line and intersecting a fixed planar closed curve.”

2) The word “axis” is simply defined by the imaginary cylinder as recited in the claims. There is no other definition in the specification as originally filed that further defines exactly what the word “axis” means. To one of ordinary skill in the art as broadly interpreted, an axis can be derived from several different ways. Normally, an axis can be defined by a moment of inertia of an object; a center of gravity of an object; an imaginary line in which an object rotates about; or simply a fixed imaginary line that provides a

point/line of reference for an object. Simply reciting that an axis is defined by the imaginary cylinder does not specifically describe where the axis should be located. In other words, the language “an axis defined by the imaginary cylinder” does not automatically or inherently position the axis in the center of the imaginary cylinder as shown in Fig. 11 of the present invention as the phantom line 45. (It is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).)

Going back to the appellant’s argument, the appellant asserts that Cheng’s clamp members define “two cylinders, one larger than the other, and each having a passageway aligned with the center axis”, since the clamp members 28 has a reduced diameter portion on one side and an enlarged diameter portion on the other side. The appellant’s assertion may be true, but it is not false to assert that there can be one imaginary cylinder that is defined by an arc portion on the reduced diameter portion and an arc portion on the enlarged diameter portion of Cheng’s clamp members making the imaginary cylinder to look like an “egg-like” oval shaped cylinder. The claim language does not limit the definition of the imaginary cylinder to be defined by the **entire** outer surface of the clamp members, but rather “outer surface **portions**” define the imaginary cylinder. Therefore, it is well within the definition as set forth in the claim language that the oval shaped imaginary cylinder can be defined by the opposite end arc portions which are part of the “outer surface portions” of Cheng’s clamp members. As a result of the imaginary cylinder being an egg-shaped cylinder, the center axis defined by the imaginary cylinder is offset

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from the passageway as shown in Fig. 1 below. (Note: the Examiner interpreted the axis defined by the imaginary cylinder of Cheng to be the center axis of the imaginary cylinder so that it would be consistent with the appellant's axis as shown in Fig. 11, although the axis of Cheng could have been positioned anywhere along the imaginary cylinder as broadly interpreted.)

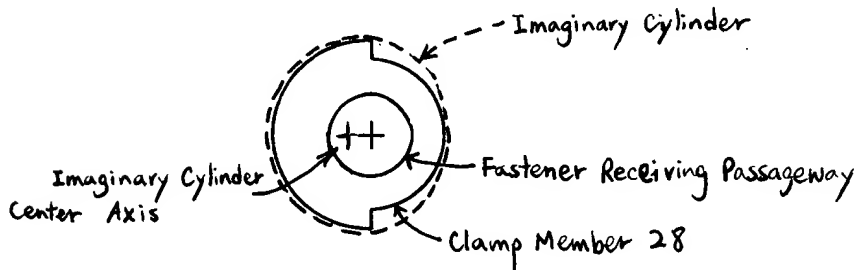


FIG 1 (Grossly Exaggerated View)

Even if the limitation, "outer surface portions", means the entire outer surface of the clamp members, Cheng's imaginary cylinder can be defined so that the axis of the imaginary cylinder is offset from the passageway. As shown in Fig. 2 below, an axis A, for example, can be positioned offset from the passageway along the imaginary cylinder that is defined by the entire outer surface of the clamp member of Cheng, since the present claim language does not provide specifically how the axis defined by the imaginary cylinder in the present invention is defined.

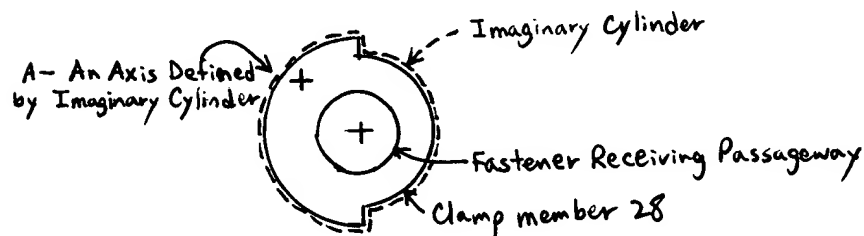


FIG 2

C) The Double Patenting Rejection

In response to the appellant's argument that the double patenting rejection should be withdrawn because neither the co-pending application, 09/658,509, nor the Cheng patent discloses or teaches the imaginary cylinder defined by the outer surface portions of the clamp members and having at least one fastener receiving passageway being offset from an axis of the cylinder, and because the present claims are directed to patentably distinct aspects of the bicycle stem and there will exist no improper timewise extension of the right to exclude, it is the Examiner's contention that the double patenting rejection is proper. First of all, the co-pending patent application, 09/658,509, is directed to at least similar, if not same, aspects of the bicycle stem. One bicycle stem being **adapted** to be attached to the steering tube and the other being **adapted** to attach the handlebar does not mean that those stems are patentably distinct. The steering tube and the handlebar are the environment in which the claimed bicycle stem is **intended** to be utilized in. Their intentions are not given patentable weight. The bicycle stem disclosed in the present invention is actually the same bicycle stem disclosed in the co-pending patent application 09/658,509 and both applications seek to protect the bicycle stem in general that include the handlebar clamping portion and the steering tube clamping portion in the claims. Both applications exclude certain limitations in the claims that can be modified by the Cheng reference as discussed in the Final rejection made on May 1, 2003, paper No. 20. Moreover, as discussed above in the response to the appellant's argument in section B), Cheng shows the imaginary cylinder defined by the outer surface portions of the clamp members and having at least one fastener receiving passageway being offset from an axis of the cylinder. And lastly, the nonstatutory double patenting rejection is provided to prevent two major issues, one being

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improper ownership and the other being unfairly extending time period for the right to exclude.

The appellant's statement in the argument that "there will exist no improper timewise extension of the right to exclude" is not a sufficient reason to withdraw the rejection. The appellant should file a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the provisional double patenting rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

chk

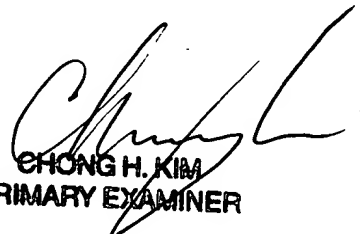
November 7, 2003

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